

### **REMARKS**

The Applicant would like to thank the Examiner for the opportunity to engage in a telephonic interview with the Examiner on October 26, 2006. During the interview, the Applicant distinguished the Williams reference from the present invention as claimed in the present claims, particularly as amended. As discussed with the Examiner, the Williams reference fails to teach a device that grabs and lifts a rail panel, such that the rail panel is held by the grabbing device and is lifted by lifting the grabbing device.

By this paper, the foregoing claims have been amended and new claim 43 has been added. In view of the amendments to the claims and the following remarks, Applicant respectfully requests reconsideration and allowance. Basis for the amendments herein is found throughout the specification, drawings, and original claims.

#### **I. The Rejection Under 35 U.S.C. § 102(b) Should Be Withdrawn.**

The Examiner rejected claims 1-4, 6-12, 14-19, 21-25, 27-31, 33-35, 38-40, and 42 as being anticipated by Williams, U.S. Patent No. 6,089,163 ("Williams"). Applicant respectfully traverses the rejection at least because Williams fails to disclose each and every claim element. For example, independent claim 1 recites a device for grabbing a rail panel, "wherein, when said frame is mounted on the rail panel and said plurality of moveable elements move outwardly from the retracted position to the extended position . . . said grabbing device is fixed to the rail panel such that the rail panel is held by the grabbing device and is lifted by lifting the grabbing device."

Williams, however, is directed to a device for "adjusting the separation distance between adjacent rails." *See* Abstract. A device that adjusts the separation distance between rails is not

"fixed to [a] rail panel such that the rail panel is held by the grabbing device and is lifted," as claimed.

Furthermore, Williams is not inherently capable of being fixed to a rail panel. According to the M.P.E.P., "[i]n relying upon a theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. §2112.IV. (citing *Ex parte Levy*, 17 USPQ2d 1461, (B.P.A.I. 1990) (emphasis in original). This theory fails because the claimed limitation does not necessarily flow from the teachings of Williams.

According to the teachings of Williams, the rail adjustment device **cannot** be fixed to a rail panel. For example, Fig. 4 and the accompanying description in column 3, lines 60-66 specify that lug 92 "is spaced inwardly . . . by a distance sufficient to provide a separation distance between the first lug 74 and the third lug 92 as permits the interposition of the rail R' between these lugs." Lugs 82 and 96 are also spaced apart in a similar manner. See Figs. 4-5, col. 3, line 65 - column 4, line 8. Therefore, the rails on a rail panel would slip out from the spaces between the lugs if the device were placed onto a rail panel and then lifted up. A device from which a rail panel would slip cannot possibly constitute a device for grabbing a rail panel. Williams merely describes a device for "adjusting the separation distance between adjacent rails." See Abstract. Therefore, Williams neither explicitly nor inherently describes a device that is capable of being "fixed" to a rail panel, as claimed.

Accordingly, the § 102(b) rejection of claims 1, 10, 16, 24, 28, and 38 should be withdrawn. In addition, the § 102(b) rejection of claims 2-4, 6-9, 11-12, 14, 15, 17-19, 21-23,

25, 27, 29-31, 33-35, 39-40, and 42, which depend from one of allowable claims 1, 10, 16, 24, 28, and 38, should be withdrawn.

## **II. The Rejections Under 35 U.S.C. § 103(a) Should Be Withdrawn.**

The Examiner rejected claims 5, 13, 20, 26, 32, 36, 37, and 41 as being unpatentable over Williams in view of Young, U.S. Patent No. 5,191,839 ("Young"). No prima facie case of obviousness exists with respect to claims 5, 13, 20, 26, 32, 36, 37, and 41, at least because the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in applicant's disclosure." M.P.E.P. § 2143.

Claims 5, 13, 20, 26, 32, 36, 37, and 41, at least by virtue of their dependence from one of independent claims 1, 10, 16, 24, 28, and 38, include the claim limitations discussed above. Furthermore, as discussed above, the Examiner has not established that the rail adjustment device in Williams meets each and every limitation of the claims. In fact, Williams does not teach or suggest fixing the rail adjustment device to a rail panel. Instead, the device in Williams is designed to permit the interposition of rails between the lugs. See col. 3, ll. 65-66. Merely permitting interposition of rails between lugs differs from the arrangement required by claims 1, 10, 16, 24, 28, and 38. Accordingly, Williams fails to teach or suggest each and every element

of the independent claims and, therefore, fails to teach or suggest each and every element of the dependent claims.

Young, relied on for its alleged disclosure of "a rail handling apparatus having first and second hydraulic rams," (Aug. 9, 2006 Office Action, p. 3) fails to cure the deficiencies of Williams identified above. Therefore, no prima facie case of obviousness exists with respect to claims 5, 13, 20, 26, 32, 36, 37, and 41, at least by virtue of their dependence from at least one of independent claims 1, 10, 16, 24, 28, and 38. Accordingly, the § 103(a) rejection of claims 5, 13, 20, 26, 32, 36, 37, and 41 should be withdrawn.

#### **Conclusion**

Thus, Applicant respectfully submits that all pending claims are now in condition for allowance. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 9th day of February, 2007.

Respectfully submitted,

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